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10/562,094	12/21/2005	Kazuo Hayashi	58805US004	8134
32692	7590	06/04/2009	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427				DESAI, ANISH P
ART UNIT		PAPER NUMBER		
1794				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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1. Continuation of Box 11:

2. With respect to the 35 USC Section 112-first paragraph rejection to claim 10, it is submitted that applicant's present amendment fails to overcome the aforementioned rejection. While applicant has cited that support for the newly added language is on page 7 lines 16-21 of the specification, the Examiner submits that said citation does not support the newly added language of the size of the "transparent regions increases further from the opaque region". While there is a support to state "The part 22 consisting of an opaque region having ...A ratio of the area of the transparent regions to that...opaque part", there is no explicit support for the newly added claim language of claim 10. As such, the 35 USC Section 112-first paragraph rejections are sustained.
3. With respect to the 35 USC Section 102(b)/103(a) rejections based on Kentaro (JP 2002-002192), applicant argues that on page 5 paragraph 0004, Kentaro teaches "the film has a design pattern...continuously increase or decrease...". Applicant asserts that when this is read a whole it is clearly shows that the gradation pattern of Kentaro is continuous. Applicant further argues that "Measurement of chromacity at various points along the surface of a gradation pattern of the presently claimed invention would not show a continuous increase or decrease because the pattern contains discrete regions and is not a pattern that continuously increases or decreases in color as taught by Kentaro. This is shown graphically in the graph on the right side of Figure 2 of the present application....".

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4. The Examiner respectfully disagrees. It is submitted that applicant's arguments are not found persuasive as they are not supported by a suitable declaration or affidavit. As set forth in MPEP 716.02(g), "the reason for requiring evidence in a declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 24 and 18 U.S.C. 1001". The Examiner submits that there is no evidence that the gradation pattern of Kentaro, which is formed by same process as that of the present invention (see paragraphs below) is different than that presently claimed.

5. Additionally, the Examiner submits that with respect to applicant's arguments based on Figure 2 of the present invention, said arguments are not fully commensurate in scope with the claimed invention, because presently claimed invention does not require discontinuity of the change of the percentage of opaque regions as one progress across the surface of the sheet. Further, it is noted that Kentaro only states that "at least one" of the stimulus values for chromaticity continuously increases or decreases. Therefore, it is not required, for instance, that L^* (where $L^*=0$ indicates transparent and $L^*=100$ indicates opaque), continuously increase or decrease.

6. Further, the Examiner submits that as set forth in the Final Office action, applicant's shading decorative sheet and that of Kentaro are formed of same process and has same structure.

7. Applicant's decorative sheet has a structure of a transparent base layer having a decorative layer on one surface of the base layer, wherein the decorative layer has a

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gradation pattern at least in one direction. Further, an adhesive layer is provided on the back surface of the base layer. It is noted that Kentaro teaches a decorative film (equated to Applicant's shading decorative sheet) (0001, page 4). The decorative film of Kentaro comprises a base layer having a design pattern formed on at least one surface of the base layer, wherein the design pattern comprises a plurality of design elements in which at least 50% of the regions have a certain gradation in one or more directions (0004, page 5). Additionally, Kentaro teaches that an adhesive layer can be formed on the decorative layer or on the base sheet.

8. Further, with respect to a method of forming Applicant's decorative layer having gradation, paragraph 0021 of Applicant's US Patent Application Publication 2007/0116949A1, following is disclosed:

[0021] The decorative layer 2 is usually formed on the front surface of the thermoplastic resin film using colorants. The decorative layer 2 may be formed on the front surface of the thermoplastic resin film by any of conventional printing methods such as gravure printing, electrostatic printing, electrophotography, screen printing, ink jet printing, offset printing, thermal transferring, etc. The colorants used to form the decorative layer 2 are usually toners or inks.

9. Additionally, Example 1 in the specification discloses use of gravure printing on the front face of a film to create a decorative sheet having a gradation pattern.

10. Kentaro discloses same methods as that of Applicant in forming the decorative layer having a gradation pattern. At paragraph 0027, Kentaro teaches "The decorative

layer 3 can have a pattern printed on the front or back side of the base sheet 2...The decorative layer 3 is usually formed as a printed layer...A color ink containing a pigment or dye of the appropriate color can also be used." Further at paragraph 0048, Kentaro teaches "***Methods that can be used for form[ing] the printed layer constituting these decorative patterns include printing methods common in the art such as the offset printing method, gravure printing method, and screen printing method.***
If a design pattern has gradation of the present invention, the offset printing method and the gravure printing method are especially suitable..."

11. Based on the aforementioned facts, the decorative sheets of Kentaro and that of Applicant are formed of identical process and have same structure. Therefore, the aforementioned features would necessarily be present. The burden is shifted to Applicant to prove it otherwise (see *In re Fitzgerald*, 205 USPQ 594). In addition, the presently claimed properties would obviously have been present once the shading decorative sheet of Kentaro is provided (see *In re Best*, 195 USPQ at 433, footnote 4 CCPA 1977). Accordingly, Kentaro anticipates or strongly suggests the presently claimed invention.

12. **Continuation of Box 12:**

13. The information disclosure statement filed on 05/12/09 fails to comply with 37 CFR 1.97(d) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered (see MPEP 609.04 (b)(III)). Further, it is noted that applicant has cited two

JP documents, however there is no publication date (if any) and name of patentee or applicant is given.

/A. D./

Examiner, Art Unit 1794

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1794